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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GODDARD, LAURA B

ART UNIT PAPER NUMBER

1642

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,113

Applicant(s)

RIEGEL ET AL.

Examiner

Laura B. Goddard, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 22-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Election filed June 23, 2006 in response to the Office Action of March 24, 2006 is acknowledged and has been entered. Applicants elected Group II (claims 18-21) without traverse.

Claims 1-53 are pending. Claims 1-17 and 22-53 are withdrawn from further consideration by the examiner under 35 CFR 1.142(b) as being drawn to non-elected inventions. Claims 18-21 are currently under prosecution.

Priority

2. The specification states priority of this application to US Provisional Application No. 60/302,648 filed 7/5/2001. However, 60/302,648 expired on 8/31/2003 before the instant application was filed on 1/5/2004, hence the instant application does not receive the priority date of 7/5/2001 from 60/302,648. It is also noted that 60/302,648 has only Figures 1-6 and lacks Figures 7-9 of the instant application.

Specification

3. The disclosure is objected to because of the following informalities: The specification comprises a question mark, "?", on many pages where it seems there should be a delta "Δ" when referencing Δ3-AIB1. Appropriate correction is required.

4. The disclosure is objected to because of the following informalities: The heading on page 6, "Description of the Figure", should be "Description of the Figures".

Appropriate correction is required.

Claim Objections

5. Claim 19 is objected to because of the following informalities: Claim 19 appears to have a typo. There is a question mark "?" that should be changed to a delta "Δ" when referring to Δ3-AIB1. Appropriate correction is required.

6. Claim 18 is objected to for containing subject material that is drawn to a non-elected invention. The claims recite "isoform of **claim 1**" which is a non-elected claim. Amendments of the claims to include all of the limitations of claim 1 and to delete referenced claim 1 would obviate the rejection. Appropriate correction is required.

7. Claim 18 is objected to because of the following informalities: Claim 18 appears to have a typo: "An isolated nucleic sequences" should be "An isolated nucleic acid sequence" in singular form. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of laboratory designations only to identify a particular protein or protein fragment such as "**AIB1**" or "**Δ3-AIB1**" renders the claims indefinite because different laboratories may use the same laboratory designation to define completely distinct proteins or protein fragments. Amendment of the claims, for example, to include the **SEQ ID number** which unambiguously defines a given protein or protein fragment, would obviate the rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Reiter et al (J of biological Chemistry, 2001, 276:39736-39741, IDS).

The claims are drawn to an isolated nucleic acid sequence that encodes an isoform of an AIB1 transcriptional coactivator (claim 18), the nucleic acid of claim 18 wherein the isoform is $\Delta 3$ -AIB1 (claim 19), a vector that contains the nucleic acid of claim 18 (claim 20), a recombinant cell that contains the nucleic acid of claim 18 (claim 21).

Reiter et al teach a nucleic acid encoding the isoform $\Delta 3$ -AIB1, a vector containing the nucleic acid and a recombinant cell containing the nucleic acid (abstract; p. 39763-39738)

10. Claims 18, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al (Cell, 1997, 90:569-580).

The claims are drawn to an isolated nucleic acid sequence that encodes an isoform of an AIB1 transcriptional coactivator (claim 18), a vector that contains the nucleic acid of claim 18 (claim 20), a recombinant cell that contains the nucleic acid of claim 18 (claim 21).

Chen et al teach an isolated nucleic acid that encodes an isoform of ACTR (p. 570, col. 1-2; Fig. 1; p. 571, col. 2; Fig. 2) (see sequence search result #15, GenEmbl database). Chen et al teach a vector containing the ACTR nucleic acid and a recombinant cell containing the ACTR nucleic acid (p. 576, col. 1; p. 578, col. 1). As evidenced by Information Hyperlinked over Proteins (iHOP) (p. 1), ACTR is a synonym for AIB1.

Art Unit: 1642

11. Claims 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeshita et al (J of Biological Chemistry, 1997, 272:27629-27634).

The claims are drawn to an isolated nucleic acid sequence that encodes an isoform of an AIB1 transcriptional coactivator (claim 18) and a vector that contains the nucleic acid of claim 18 (claim 20).

Takeshita et al teach a nucleic acid that encodes an isoform of TRAM-1 and a vector containing the nucleic acid (p. 27629, col. 2; Fig. 1; p. 27630, col. 2; p. 27631, col. 2) (see sequence search result #4, GenEmbl database). As evidenced by Information Hyperlinked over Proteins (iHOP) (p. 1), TRAM-1 is a synonym for AIB1.

12. Claims 18, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,562,589, Meltzer et al, issued 5/13/2003, filed 8/21/1998.

The claims are drawn to an isolated nucleic acid sequence that encodes an isoform of an AIB1 transcriptional coactivator (claim 18), a vector that contains the nucleic acid of claim 18 (claim 20), a recombinant cell that contains the nucleic acid of claim 18 (claim 21).

Meltzer et al teach an isolated nucleic acid sequence that encodes an isoform of AIB1 (SEQ ID NO:1), a vector containing the nucleic acid, and a recombinant cell that contains the nucleic acid (col. 2, lines 35-38; col. 3, lines 35-40; col. 4, lines 29-30; Fig. 6; Example 1 and Example 2) (see sequence search result #2, issued patent database).

13. **Conclusion:** No claim is allowed.

Art Unit: 1642

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura B. Goddard, Ph.D. whose telephone number is (571) 272-8788. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laura B Goddard, Ph.D.
Examiner
Art Unit 1642


JEFFREY SIEW
SUPERVISORY PATENT EXAMINER